

Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 3767
Application No. 10/820,275
Paper Dated June 26, 2007
In Reply to USPTO Correspondence of March 26, 2007
Attorney Docket No. 3896-071834 (P-5690)

REMARKS

The final Office Action of March 26, 2007 has been reviewed and the Examiner's comments carefully considered. The present Amendment amends claim 1 in accordance with the originally-filed specification. No new matter has been added. Moreover, the present Amendment does not add any new issues for additional searching, since the claim language is merely being clarified based on what was previously argued. Accordingly, claims 1-34 are currently pending in this application, and claims 1, 19, 22 and 27 are in independent form.

Allowable Subject Matter

Initially, the Applicant would like to thank the Examiner for indicating that the subject matter of claims 6-34 define over the prior art of record. Specifically, the Examiner has indicated that claims 6-18 would be allowable if rewritten in independent form including the base claim and any intervening claims. The Examiner has also indicated that claims 19-34 are allowed.

35 U.S.C. §102 Rejections

Claims 1-5 stand rejected under 35 U.S.C. §102(a) as being anticipated by European Patent Application Publication No. EP 1 208 862 to Newby et al. (hereinafter "the Newby application"). In view of the above amendments and the following remarks, the Applicant respectfully requests reconsideration of this rejection.

As defined by amended independent claim 1, the present invention is directed to a shieldable needle assembly comprising: a needle cannula having a proximal end and a distal end; a hub mounted to the needle cannula at a location spaced from the distal end; a shield axially slidable over the needle cannula between a fully retracted position and a fully extended position encapsulating the distal end of the needle cannula; a first biasing member biasing the shield towards the fully extended position; a lock for releasably maintaining the shield in the fully retracted position; an actuator for releasing the lock; and a retaining member engageable with the shield. The retaining member is distinct from the lock. After activation of the actuator and release of the lock, the retaining member engages the shield. The shield is thereby prevented from moving to the fully extended position until the retaining

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member is disengaged from the shield, such as after the tube is removed from a needle holder.

The Newby application discloses a needle assembly having a telescoping shield (3) that extends over a distal (6) end of a needle (2) when released by an actuator (4) that is triggered during a standard sequence of operation during a medical procedure.

The Newby application does not teach or suggest a retaining member that is distinct from the lock and that after activation of the actuator and release of the lock, the separate retaining member engages the shield, thereby preventing it from moving to the fully extended position until the retaining member is disengaged from the shield, as required by independent claim 1. The shield (3) of the Newby application includes lugs (11) that are located in a proximal pocket (56) of the needle hub (5). Each of these lugs (11) is held in place in each pocket (56) by a respective retention rib (57) (see paragraph [0023] of the Newby application).

The Examiner contends that these retention ribs (57) are equivalent to the retaining structure of independent claim 1. However, the retention ribs are clearly described in paragraph [0023] of the Newby application as holding the lugs (11) of the shield (3) in place *prior* to the activation of the actuator. Accordingly, the retention ribs (57) are more accurately defined as part of the locking mechanism. Independent claim 1 has been amended hereinabove to clarify the retaining structure as being distinct from the lock.

In addition, claim 1 has also been amended to clarify that *after* the activation of the actuator and release of the lock, the retaining member engages the shield such that the shield is thereby prevented from moving to the fully extended position until the retaining member is disengaged from the shield. Paragraph [0023] of the Newby application clearly describes that upon activation of the actuator (4), the shield (3) is rotated and the lugs (11) are moved over the retention ribs (57) into their respective channels (54) and the compression spring (19) causes distal movement of the shield (3). Accordingly, the retention ribs (57) of the Newby application cannot be considered to engage the shield *after* activation of the actuator as required by independent claim 1. Quite simply, Newby releases a lock to cause the shield to be released. Claim 1 of the present invention releases the lock to cause the shield to be released, but also causes a separate retaining member to engage the shield, to

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prevent full release of the shield until a later release, such as upon removal of the tube. Newby fails to disclose this further engagement.


For at least the foregoing reasons, the subject matter of amended independent claim 1 is not anticipated by the Newby application. Reconsideration of the rejection of claim 1 is respectfully requested.

Claims 2-5 depend from and add further limitations to amended independent claim 1 or a subsequent dependent claim and are believed to be patentable for at least the reasons discussed hereinabove in connection with amended independent claim 1. Reconsideration of the rejection of claims 2-5 is respectfully requested.

Based on the foregoing amendments and remarks, entry of the above amendments, reconsideration of the rejections and allowance of pending claims 1-5 and continued allowance of claims 6-34 are respectfully requested.

Respectfully submitted,

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